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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,589	09/22/2005	Steffen Schule	PSEE200020	9122
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Fay Sharpe LLP 1228 Euclid Avenue, 5th Floor The Halle Building Cleveland, OH 44115				
EXAMINER				
SAYALA, CHHAYA D				
ART UNIT		PAPER NUMBER		
1794				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,589

Applicant(s)

SCHULE ET AL.

Examiner

C. SAYALA

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/26/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102/Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jacobsen et al. (US Patent 5391371).

The reference shows, at Example 1, an animal feed additive that is granulated and includes cellulose of the type claimed (ARBOCEL). If the cellulose is of the same type, then the properties attributed to the cellulose such as "limiting food intake" or "water-retention capacity" or "high swelling capacity" or "reduces energy content" must be inherent. Since the patent teaches a granulated form, then the additive has been "compacted", or pelleted (col. 4, line 57). As for amounts of fiber in the pellet, see claim 3, which includes the amounts claimed herein. This rejection is being made both statutes because even though the reference does not teach the swelling capacity and the water-holding capacity, these physical characteristics are either inherent or rendered obvious. Furthermore, the burden is being shifted to applicant to show that these characteristics are not part of the reference cellulose because the Office does not have the resources to measure such characteristics of the prior art product by the Weender analytical method. As for the limitation comparing animal food containing the additive with animal food not containing the additive, the latter being in the stomach longer, the claims herein are drawn to product claims and since applicant has chosen to describe his product with such characteristics that cannot

be compared with prior art products, because the Office does not have the ability to do so, the burden is being shifted to applicant to make that comparison with that of prior art. See *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972)

As for claims 4-6 and 8-10, the patent then shows adding the additive to a fodder composition. Since the Arbocel is 2 kgs in a 20 kg granulate and 2 kgs of the granulate is added to 10 kgs of fodder, then claim 5 is met. Note too that a pelleted fodder is disclosed containing the granulate, at col. 4, line 57.

With regard to the additive being for an animal that is pregnant, lactating etc., this is use terminology which has no patentable weight in a product/composition claim. See *In re Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau*, 57 USPQ 324.

2. Claims 1-11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Henriksen et al. (US Patent 6610519).

The reference shows, at Example 3, an animal feed additive that is granulated and includes cellulose of the type claimed (ARBOCEL) in the same amount. This rejection is being made both statutes because even though the reference does not teach the swelling capacity and the water-holding capacity, limiting food intake, reducing energy content, these physical characteristics are either inherent or rendered obvious. Furthermore, the burden is being shifted to applicant to show that these characteristics are not part of the reference cellulose because the Office does not have the resources

to measure such characteristics of the prior art product by the Weender analytical method. As for the limitation comparing animal food containing the additive with animal food not containing the additive, the latter being in the stomach longer, the claims herein are drawn to product claims and since applicant has chosen to describe his product with such characteristics that cannot be compared with prior art products, because the Office does not have the ability to do so, the burden is being shifted to applicant to make that comparison with that of prior art. See *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972)

As for claims 4-6 and 8-10, the patent then shows adding the additive to a feed composition and then being pelleted, at Example 5. Amounts calculated based on the ingredients given therein coincide with those claimed herein.

With regard to the additive being for an animal that is pregnant, lactating etc., this is use terminology which has no patentable weight in a product/composition claim. See *In re Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau*, 57 USPQ 324.

3. Claims 1-2, 4-5 and 8 & 11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Backers (US Pub 2004/0047897).

The reference shows, at page 2, col. 2, and page 3, col. 1, an animal feed additive that includes cellulose of the type claimed. This rejection is being made both statutes because even though the reference does not teach the swelling capacity and

the water-holding capacity or reducing energy content, these physical characteristics are either inherent or rendered obvious. Furthermore, the burden is being shifted to applicant to show that these characteristics are not part of the reference cellulose because the Office does not have the resources to measure such characteristics of the prior art product by the Weender analytical method. As for the limitation comparing animal food containing the additive with animal food not containing the additive, the latter being in the stomach longer, the claims herein are drawn to product claims and since applicant has chosen to describe his product with such characteristics that cannot be compared with prior art products, because the Office does not have the ability to do so, the burden is being shifted to applicant to make that comparison with that of prior art. See *In re Brown*, 459 F.2d 531,535,173 USPQ 685, 688 (CCPA 1972)

As for claim 5, see claim 11.

With regard to the additive being for an animal that is pregnant, lactating etc., this is use terminology which has no patentable weight in a product/composition claim. See *In re Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau*, 57 USPQ 324.

4. Claims 3, 7 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Backers in view of De Lima et al. (US Patent 6403549) or Jorgensen et al. (US Patent 6924133).

The primary reference is as discussed above, but it does not describe the composition being compacted. The secondary references describe compositions that

can be compacted to granular forms and such granules being used as animal feed. The compositions contain the same or similar cellulose. See col. 13, line 41 and Example 8 in '549 and col. 9, lines 13-31, col. 15, lines 12 and 33 in '133. To incorporate such compacting in the Backers reference would have been obvious to one of ordinary skill in the art for the benefits that granules bring, which is ease of shipping and handling. Note too that animal feeds and fish feed is generally provided in the form of pellets and granules.

Response to Arguments

Applicant's arguments filed 3/26/2009 have been fully considered but they are not persuasive.

At page 5, applicant has traversed Jacobsen by stating that Jacobsen does not teach the properties or features claimed herein. However, Jacobsen teaches the same composition and discovering additional properties or features cannot establish the patentability of the same old composition. Additionally, applicant states that

Food that increases digestion would in fact teach against swelling water holding, since food would have to be quickly released. If the fodder was to swell and hold water, an animal's digestion would slow.

However, such remarks are unsubstantiated. And even if they were not, it is unclear what the bearing of this feature is on the instantly claimed composition, because the instantly claimed additive does not exclude enzymes or pelletization. Jacobsen

discloses that it is the **pelletizing of fodder** that increases digestibility (col. 1), and therefore pelletizing with cellulose should also be reasonably expected to increase digestibility. In any event, neither applicant's remarks nor the specification establishes that pelletizing the food additive with cellulose had any effect on digestibility. In fact the specification states at page 6, line 29:

The swelling and the fiber's own capillary effect of the lignocellulose are purely physical effects, which do not presuppose any digestive processes specific to a species.

With regard to Henriksen, applicant states that it is not inherent that the composition shown by that reference has properties such as a swelling capacity or water-holding capacity. Reason: Henriksen is not directed to increasing swelling or water-holding capacity. Applicant has not offered any substantiation to why it is that the very same cellulose claimed herein would not possess similar properties. Therefore, such an argument fails to establish patentability. Next, applicant has a discussion that the amount disclosed is not the same as claimed. This point has been carefully reviewed and the amount as referred (see Ex. 3) is shown by the reference, contrary to applicant's assertion. Therefore, this argument could not be used as the basis for patentability also.

Backers has also been criticized for not disclosing the "focus" of this invention. Applicant has argued that the intent of Backers' product, is different from applicant's. In response, the claim is to a product and the discovery of a new property or use of a previously known composition, even when that property and use are unobvious from the

prior art, cannot impart patentability to claims to the known composition. *In re Spada*, 15 USPQ 2d, 1655. With regard to Backers being commonly owned, applicant is referred to section 706.02(l)(2) of the MPEP and is reminded that establishing common ownership overcomes a rejection under 35 USC 103 but not 35 USC 102 (e).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Sayala, whose telephone number is (571) 272-1405.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/C. SAYALA/
Primary Examiner, Art Unit 1794**